

ESTTA Tracking number: **ESTTA351978**

Filing date: **06/09/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051279
Party	Plaintiff Red Hen Bread LLC
Correspondence Address	KATHRYN JENNISON SHULTZ JENNISON & SHULTZ, P.C. 2001 JEFFERSON DAVIS HIGHWAY, SUITE 1102 ARLINGTON, VA 22202 UNITED STATES kjs4jennisonlaw@aol.com
Submission	Reply in Support of Motion
Filer's Name	Kathryn Jennison Shultz
Filer's e-mail	kjs4jennisonlaw@aol.com
Signature	/Kathryn Jennison Shultz/
Date	06/09/2010
Attachments	Canc. 92051926 Petitioner's Reply.pdf ( 15 pages )(353405 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RED HEN BREAD LLC,	:	
	:	
Petitioner,	:	Cancellation No. 92/051,279
	:	(Reg. No. 3,614,763)
v.	:	
	:	
NORM OEDING,	:	
	:	
<u>Registrant.</u>	:	

PETITIONER'S REPLY TO REGISTRANT'S RESPONSE  
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT

Petitioner RED HEN BREAD LLC respectfully submits its reply to Registrant's Response to Petitioner's Motion for Summary Judgment, which is dated May 29, 2010, but contains a postmark date of June 1, 2010.

Petitioner supported its motion for summary judgment with declarations and other evidence establishing that the mark LITTLE RED HEN BAKERY is likely to cause confusion as to the source of its bakery products and to falsely suggest a trade connection with Petitioner, which has used its RED HEN BREAD trademark for bakery products for more than thirteen years in commerce.

Specifically, Petitioner's submissions demonstrate that there is no dispute as to (a) the priority of Petitioner's RED HEN BREAD mark, (b) the similarity in the appearance, sound, commercial impression and connotation of the dominant portion of the parties' marks, namely, RED HEN, (c) the virtual identicalness of the goods listed in the contested registration and the ones sold by Petitioner under the respective marks, and (d) the similarity of the unrestricted channels of trade for the goods listed in the contested

registration and the ones sold by Petitioner under the respective marks. The undisputed evidence establishes that all relevant “confusion” factors identified in the case of *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) lead to the conclusion that a likelihood of confusion exists. The Board has said that the two key considerations are the similarities between the marks and the similarities between the goods or services. *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 2008 WL 4107225 (TTAB 2008). The obligation of the Board to consider a *du Pont* factor arises only if there is evidence on that factor. There is no need for the Board to discuss all of the factors. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

A fact is “material” for purposes of summary judgment if proof of that fact would have the effect of establishing or refuting an essential element of the cause of action or a defense advanced by the parties. *Kendall v. Hoover Co.*, 751 F.2d 171,174 (6<sup>th</sup> Cir.1984). A dispute over a material fact is genuine “if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

Once the moving party carries the initial burden of demonstrating that there are no genuine issues of material fact in dispute, the burden shifts to the nonmoving party to present specific facts to prove that there is a genuine issue for trial. *Anderson*, 477 U.S. at 256. To create a genuine issue of material fact, the nonmoving party must present more than just some evidence of a disputed issue. *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586-87 (1986).

Consequently, the nonmoving party must do more than raise some doubt as to the existence of a fact; the nonmoving party must produce evidence that would be sufficient to require submission of the issue to the jury. *Express Welding Inc. v. Superior Trailers LLC*, 94 USPQ2d 1727, 1730 (E.D.Mich. 2010).

Registrant has not produced any evidence that raises the existence of a fact that prevents judgment to be reached in favor of Petitioner.

With respect to *du Pont* factor number 6 (the number and nature of similar marks in use on similar goods), the question is whether so many third parties use the shared term RED HEN that consumers will look to their points of differentiation to distinguish the marks. The answer is no. Registrant has not introduced any evidence that would make this factor relevant. In its response, Registrant mentions two cancelled registrations, which should be given no consideration because no copies of the registrations were submitted. In addition, cancelled registrations have no value. They do not provide any evidence of use in the marketplace of a trademark.

In the case of *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996), the Board found no likelihood of confusion where the applicant submitted evidence that “hundreds of businesses” use the shared term for the service (product) for which applicant sought registration. This certainly does not constitute a *Broadway Chicken* situation. In the present case, the Registrant submits “printouts” from two websites, which do not establish anything other than the fact that Registrant’s attorney visited the sites. The Registrant has not submitted any evidence to show use of similar marks on similar goods that would cause the Board to come to any conclusion other than that there is a likelihood of confusion in the present case.

Turning to the issue of actual confusion, the courts have recognized how difficult it is to obtain reliable evidence of actual confusion of buyers. It is black letter law that actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove and the Act requires only a likelihood of confusion as to source. *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 230 USPQ 831 (2d Cir. 1986). Actual confusion or deception of purchasers is not essential to a finding of trademark infringement or unfair competition, it being recognized that reliable evidence of actual confusion is practically almost impossible to secure. *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 761, 126 USPQ 310 (2d Cir. 1960). The law recognizes that random instances of confusion often go unreported or unrecorded. *Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc.*, 275 F. Supp. 2d 543, 32 Media L. Rep. 1001, 67 USPQ2D 1887, 1909 (D.N.J. 2003). Registrant's statement that he "has received no communication from any of his customers regarding the existence of RED HEN BREAD in Chicago" proves nothing.

Petitioner has proven its continuous use of its trademark prior to any date alleged or claimed by Registrant. Robert Picchiatti, the President and CEO of Red Hen Bread, LLC, has declared that Petitioner has been using its RED HEN BREAD trademark to identify its bakery products at all times from December 9, 1996 to present.

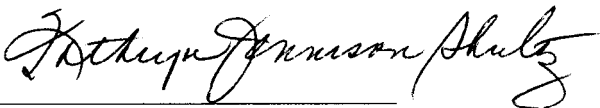
Since Registrant has sought additional direct evidence for establishing Petitioner's continuous use of its RED HEN BREAD mark, Petitioner hereby submits declarations made by a few of its numerous customers, who have purchased RED HEN BREAD bakery products from Petitioner during the years 1996 to present.

Attached, as Exhibit A, is Declaration by John Latino, who states that he has purchased RED HEN BREAD bakery products from Petitioner continuously since July 15, 1997. Attached, as Exhibit B, is Declaration by Bruce Sherman, who states that he has purchased RED HEN BREAD bakery products from Petitioner continuously since January 2, 1998. Attached, as Exhibit C, is Declaration by Matt Weygandt, who states that he has purchased RED HEN BREAD bakery products from Petitioner continuously since December 18, 2003. Additional individuals are prepared to submit similar declarations in support of Petitioner's claim of use of its RED HEN BREAD trademark prior to any date alleged or claimed by Registrant. However, Petitioner does not believe that they are necessary to prove this point.

Petitioner submits that, considering all evidence and arguments bearing on the *du Pont* factors, the only conclusion that can be made is that there is a likelihood of confusion between Registrant's LITTLE RED HEN BAKERY mark when used in connection with the goods listed in the subject registration and Petitioner's RED HEN BREAD mark when used in connection with its bakery products. Petitioner respectfully requests the Board to grant its petition and to cancel Registration No. 3,614,763.

Respectfully submitted,

Date: June 9, 2010

By:   
Kathryn Jennison Shultz  
Jennison & Shultz, P.C.  
2001 Jefferson Davis Highway -- Suite 1102  
Arlington, Virginia 22202  
Attorneys for Petitioner

## EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RED HEN BREAD LLC,	:	
	:	
Petitioner,	:	Cancellation No. 92/051,279
	:	(Reg. No. 3,614,763)
v.	:	
	:	
NORM OEDING,	:	
	:	
_____ Registrant.	:	

DECLARATION OF JOHN LATINO IN SUPPORT OF  
PETITIONER'S MOTION FOR SUMMARY JUDGMENT

I, John Latino, declare as follows:

1. I have personal knowledge of the facts stated herein. I submit this Declaration in support of Petitioner's Motion for Summary Judgment.
2. Since July 15, 1997, I have been a customer of Petitioner Red Hen Bread, LLC, which has a place of business at 250 N. Western Avenue, Chicago, Illinois.
3. Since at least as early as July 15, 1997, Petitioner Red Hen Bread, LLC, has prominently displayed on signs, advertisements, menus and packaging associated with its bakery products its RED HEN BREAD trademark.
4. I know that RED HEN BREAD bakery products, such as fresh baked bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries have been made, distributed and sold continuously since at least as early as July 15, 1997.



5. Since July 15, 1997, I have purchased RED HEN BREAD bakery products from  
Petitioner Red Hen Bread, LLC.

I declare that all statements made herein of my own knowledge are true and all  
statements made on information and belief are believed to be true; and further that the  
statements were made with the knowledge that willful false statements and the like so  
made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of  
the United States Code.

Respectfully submitted,

Date: 6.7.10

By: 

John Latino

Bongo Room  
1470 N. Milwaukee  
Chicago, Illinois 60647

## EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

RED HEN BREAD LLC,

Petitioner,

v.

NORM OEDING,

Registrant.

:  
:  
: Cancellation No. 92/051,279  
: (Reg. No. 3,614,763)  
:  
:  
:

**DECLARATION OF BRUCE SHERMAN IN SUPPORT OF**  
**PETITIONER'S MOTION FOR SUMMARY JUDGMENT**

I, Bruce Sherman, declare as follows:

1. I have personal knowledge of the facts stated herein. I submit this Declaration in support of Petitioner's Motion for Summary Judgment.
2. Since January 2, 1998, I have been a customer of Petitioner Red Hen Bread, LLC, which has a place of business at 250 N. Western Avenue, Chicago, Illinois.
3. Since at least as early as January 2, 1998, Petitioner Red Hen Bread, LLC, has prominently displayed on signs, advertisements, menus and packaging associated with its bakery products its RED HEN BREAD trademark.
4. I know that RED HEN BREAD bakery products, such as fresh baked bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries have been made, distributed and sold continuously since at least as early as January 2, 1998.

5. Since January 2, 1998, I have purchased RED HEN BREAD bakery products from  
Petitioner Red Hen Bread, LLC.

I declare that all statements made herein of my own knowledge are true and all  
statements made on information and belief are believed to be true; and further that the  
statements were made with the knowledge that willful false statements and the like so  
made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of  
the United States Code.

Respectfully submitted,

Date: 8 Jun 2010

By:   
Bruce Sherman

North Pond Restaurant  
2610 N. Cannon Drive  
Chicago, Illinois 60657

## EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RED HEN BREAD LLC,	:	
	:	
Petitioner,	:	Cancellation No. 92/051,279
	:	(Reg. No. 3,614,763)
v.	:	
	:	
NORM OEDING,	:	
	:	
<u>Registrant.</u>	:	

DECLARATION OF MATT WEYGANDT IN SUPPORT OF  
PETITIONER'S MOTION FOR SUMMARY JUDGMENT

I, Matt Weygandt, declare as follows:

1. I have personal knowledge of the facts stated herein. I submit this Declaration in support of Petitioner's Motion for Summary Judgment.
2. Since December 18, 2003, I have been a customer of Petitioner Red Hen Bread, LLC, which has a place of business at 250 N. Western Avenue, Chicago, Illinois.
3. Since at least as early as December 18, 2003, Petitioner Red Hen Bread, LLC, has prominently displayed on signs, advertisements, menus and packaging associated with its bakery products its RED HEN BREAD trademark.
4. I know that RED HEN BREAD bakery products, such as fresh baked bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries have been made, distributed and sold continuously since at least as early as December 18, 2003.

5. Since December 18, 2003, I have purchased RED HEN BREAD bakery products from Petitioner Red Hen Bread, LLC.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Respectfully submitted,

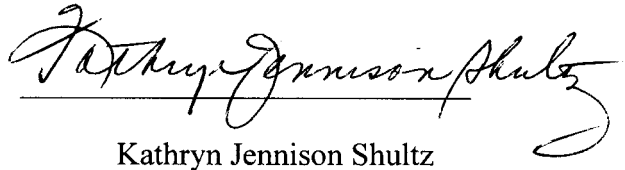
Date: 6-7-10

By: Matt Weygandt  
Matt Weygandt

Barriques Market  
5957 McKee Road  
Fitchburg, Wisconsin 53719

CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of the foregoing PETITIONER'S  
REPLY TO REGISTRANT'S RESPONSE TO PETITIONER'S MOTION FOR  
SUMMARY JUDGMENT, DECLARATION OF JOHN LATINO IN SUPPORT OF  
PETITIONER'S MOTION FOR SUMMARY JUDGMENT, DECLARATION OF  
BRUCE SHERMAN IN SUPPORT OF PETITIONER'S MOTION FOR SUMMARY  
JUDGMENT and DECLARATION OF MATT WEYGANDT IN SUPPORT OF  
PETITIONER'S MOTION FOR SUMMARY JUDGMENT were served upon Registrant  
by mailing same via First Class Mail, postage prepaid, to Registrant's counsel, Robert O.  
Blinn, P.O. Box 75144, Wichita, Kansas 67275-0144, this 9th day of June, 2010.

  
Kathryn Jennison Shultz